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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,645	04/02/2004	Kia Silverbrook	HYG007US	9662
24011	7590	04/10/2006	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, NSW 2041 AUSTRALIA			PHAM, THOMAS K	
			ART UNIT	PAPER NUMBER
			2121	

DATE MAILED: 04/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/815,645	SILVERBROOK ET AL.	
	Examiner	Art Unit	
	Thomas K. Pham	2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,12,13,19-37,39,40,42,44 and 45 is/are rejected.
- 7) ☒ Claim(s) 3-11,14-18,38,41 and 43 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

First Action on the Merits

1. Claims 1-45 of U.S. Application 10/815,645 filed on 04/02/2004 are presented for examination.

Quotations of U.S. Code Title 35

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Abstract

6. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

7. The abstract of the disclosure is objected to because the abstract should be written in technical language not the legal language used in the claims. Correction is required. See MPEP § 608.01(b).

Claim Objections

8. Claims 38, 41 and 43 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim *should refer to one other claims in the alternative only, and/or, cannot depend from any other claim at the same time*. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

9. Claims 20 and 21 are objected to because of the following informalities: it is obvious that applicants have left out the phrase "using a component" at line 1 of the claims before the comma (,). Appropriate correction is required.

Claim Rejections - 35 USC § 102

10. Claims 1, 2, 12, 13, 19-23, 25, 30, 31, 33-36, 39, 40, 42, 44 and 45 rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 6,314,337 ("Marcum").

Regarding claims 1, 2, 12, 13, 19-23, 25, 30, 31, 33-36, 39, 40, 42, 44 and 45

Marcum teaches an automated consolidation station comprising: a sensing device 24 for sensing at least one coded data portion (chassis/tote ID); generating, using the sensed coded data portion, indicating data indicative of the identity of the object; and, transferring the indicating data to at least one of a packing system which is responsive to the indication to pack the object; computer system which is responsive to the indication to cause a packing system to pack the object, wherein in the packing system: receiving the indicating data; generating, from the received indicating data, object identity data indicative of the identity of the object; and, packing the object using the object identity data. Marcum discloses all the elements and the functional/method steps of these claims (see figs. 1-3, col. 3, line 35-col. 4, line 51).

Claim Rejections - 35 USC § 103

11. Claims 24, 26-29, 32, and 37, are rejected under 35 U.S.C. 103(a) as being unpatentable over Marcum. The teaching of Marcum have been discussed above.

Regarding claim 24

Marcum does not specifically disclose the EPC code. However, Official Notice is taken for the concept and advantages of having the EPC code format is old and well known in the art. It would have been obvious to a person of ordinary skill in the art to use the EPC format in

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Marcum in order to make the Marcum invention easily implemented in Europe, to make it more versatile.

Regarding claims 26 and 27

Marcum does not specifically disclose the redundancy as claimed. Official Notice is also taken the concept and advantages of having the redundancy in coded information is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide redundant information in the code of Marcum thereby helping to ensure a readable code in the case where a portion of the code may be damaged. With respect to the specific type of redundancy, such limitation falls within the engineering choice for meeting specific requirement, failing to provide any unexpected results, which therefore, an obvious extension as taught by Marcum.

Regarding claims 28 and 29

Marcum does not specifically disclose the invisible code or IR ink. Official notice is taken for the concept and advantages of having the bar codes printed, in IR ink is old and well known in the art. It would have been obvious to a person of ordinary skill in the art at the time of the invention to print the code of Kawai in IR ink. This would effectively obscure the code from the naked eye and thus would not visibly interfere with the surface of a product.

Regarding claims 32

Marcum does not specifically disclose that the code takes up at least 25% of the product surface. Official notice is taken for the concept and advantages of having codes printed on more than 25% of a surface of a product is old and well known in the art. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to print the code on

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more than 25% of the product surface in order to maximize the amount of information held within the code.

Regarding claim 37

Marcum does not specifically disclose laser scanners. However, lasers scanners are old and well known in the art. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Marcum with lasers scanners for reading code information. This would provide better signal quality to more optimal reading and thus would enhance the overall system performance.

Allowable Subject Matter

12. Claims 3-11 and 14-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record fails to teach or fairly suggest to one of ordinary skill in the art at the time the invention, in conjunction with all the other claimed limitations, the position, the orientation, of the sense code data portion, the orientation of the sensed device relative to the interface surface, indicating data indicative of the region identity, etc., as set forth in the claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Thomas Pham*; whose telephone number is (571) 272-3689, Monday - Thursday from 6:30 AM - 5:00 PM EST or contact Supervisor *Mr. Anthony Knight* at (571) 272-3687.

Any response to this office action should be mailed to: **Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450**. Responses may also be faxed to the **official fax number (571) 273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thomas Pham
Patent Examiner

A handwritten signature in black ink, appearing to read 'Tom Pham', with a stylized flourish extending from the end.

March 29, 2006